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10/583,557	06/19/2006	Kenichi Motoyama	292358US0PCT	9829
22850 7590 07/22/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER LOEWE, ROBERT S				
ART UNIT 1796		PAPER NUMBER		
NOTIFICATION DATE 07/22/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/583,557

Applicant(s)

MOTOYAMA ET AL.

Examiner

ROBERT LOEWE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's arguments/remarks, filed on 6/30/08, have been fully acknowledged.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nogami et al. (US Pat. 5,800,926), in view of Crompton OSi Specialties (Silquest A-1524 Silane product description found at [http://www.biryong.co.kr/datacenter/chemistry/Silquest\(R\)A1524Silane.pdf](http://www.biryong.co.kr/datacenter/chemistry/Silquest(R)A1524Silane.pdf), published 2002).

Nogami et al. teaches a process for preparing a film-forming composition comprising forming a reaction mixture of comprising a tetraalkoxysilane (2:40), a perfluorinated alkoxysilane (2:44), a solvent (2:49), oxalic acid (2:51), and one or more trialkoxysilane modifiers (4:52-5:7), which serve to promote adhesion and reduce the curing temperature of the

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composition. As a specific example, Nogami et al. teaches a film-forming composition comprising (1) tetrathoxysilane [formula (1) of instant claim 1], (2) tridecafluorooctyltrimethyloxysilane [formula (2) of instant claim 1], (3) aminopropyltrimethoxysilane, (4) glycidoxypolytrimethoxysilane (instant claim 2), oxalic acid and ethanol (example 3; 7:22-36). Nogami et al. further teaches the addition of a sol of the types found in instant claim 3. Nogami et al. further explicitly teaches all of the process limitation steps of instant claim 1 (2:35-64).

Nogami et al. does not explicitly teach the addition of an ureidoalkyltrialkoxysilane [formula (3) of instant claim 1]. However, Crompton OSi Specialties teaches ureidopropyltrimethoxysilane. Nogami et al. and Crompton OSi Specialties are combinable because they are from the same field of endeavor, namely, alkoxy silane adhesion promoters. At the time of the invention, a person having ordinary skill in the art would have found it obvious to employ ureidopropyltrimethoxysilane as taught by Crompton OSi Specialties into the film-forming composition as taught by Nogami et al. and would have been motivated to do so since Crompton OSi Specialties teaches that ureidopropyltrimethoxysilane offers a number of important benefits including longer pot life than aminosilanes in reactive polymer systems (page 1). This would lead one having ordinary skill in the art to replace the aminopropyltrimethoxysilane as taught in Example 3 of Nogami et al. with ureidopropyltrimethoxysilane.

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Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nogami et al. (US Pat. 5,800,926), in view of Crompton OSi Specialties (Silquest A-1524 Silane product description found at [http://www.biryong.co.kr/datacenter/chemistry/Silquest\(R\)A1524Silane.pdf](http://www.biryong.co.kr/datacenter/chemistry/Silquest(R)A1524Silane.pdf), published 2002).

Nogami et al. teaches a process for forming a coating film which comprises forming a reaction mixture of a tetraalkoxysilane (2:40), a perfluorinated alkoxyisilane (2:44), a solvent (2:49), oxalic acid (2:51), and one or more trialkoxysilane modifiers (4:52-5:7), which serve to promote adhesion and reduce the curing temperature of the composition. As a specific example, Nogami et al. teaches a film-forming composition comprising (1) tetraethoxysilane [formula (1) of instant claim 4], (2) tridecafluorooctyltrimethoxyisilane [formula (2) of instant claim 4], (3) aminopropyltrimethoxysilane, (4) glycidoxypentyltrimethoxysilane (instant claim 5), oxalic acid and ethanol (example 3; 7:22-36). Nogami et al. further teaches the addition of a sol of the types found in instant claim 6. Nogami et al. further explicitly teaches all of the process limitation steps and physical property limitations of instant claim 4 (2:35-3:4).

Nogami et al. does not explicitly teach the addition of an ureidoalkyltrialkoxysilane [formula (3) of instant claim 4]. However, Crompton OSi Specialties teaches ureidopropyltrimethoxysilane. Nogami et al. and Crompton OSi Specialties are combinable because they are from the same field of endeavor, namely, alkoxyisilane adhesion promoters. At the time of the invention, a person having ordinary skill in the art would have found it obvious to employ ureidopropyltrimethoxysilane as taught by Crompton OSi Specialties into the film-forming composition as taught by Nogami et al. and would have been motivated to do so since Crompton OSi Specialties teaches that ureidopropyltrimethoxysilane offers a number of

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important benefits including longer pot life than aminosilanes in reactive polymer systems (page 1). This would lead one having ordinary skill in the art to replace the aminopropyltrimethoxysilane as taught in Example 3 of Nogami et al. with ureidopropyltrimethoxysilane.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nogami et al. (US Pat. 5,800,926), in view of Crompton OSi Specialties (Silquest A-1524 Silane product description found at [http://www.biryong.co.kr/datacenter/chemistry/Silquest\(R\)A1524Silane.pdf](http://www.biryong.co.kr/datacenter/chemistry/Silquest(R)A1524Silane.pdf), published 2002).

Nogami et al. teaches a coating film having the physical properties of instant claim 7 which is formed from a reaction mixture comprising a tetraalkoxysilane (2:40), a perfluorinated alkoxysilane (2:44), a solvent (2:49), oxalic acid (2:51), and one or more trialkoxysilane modifiers (4:52-5:7), which serve to promote adhesion and reduce the curing temperature of the composition. As a specific example, Nogami et al. teaches a film-forming composition comprising (1) tetraethoxysilane [formula (1) of instant claim 7], (2) tridecafluorooctyltrimethyloxysilane [formula (2) of instant claim 7], (3) aminopropyltrimethoxysilane, (4) glycidoxypyltrimethoxysilane (instant claim 8), oxalic acid and ethanol (example 3; 7:22-36). Nogami et al. further teaches the addition of a sol of the types found in instant claim 9. Nogami et al. further explicitly teaches all of the process limitation steps and physical property limitations of instant claim 7 (2:35-3:4).

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Nogami et al. does not explicitly teach the addition of an ureidoalkyltrialkoxysilane [formula (3) of instant claim 7]. However, Crompton OSi Specialties teaches ureidopropyltrimethoxysilane. Nogami et al. and Crompton OSi Specialties are combinable because they are from the same field of endeavor, namely, alkoxy silane adhesion promoters. At the time of the invention, a person having ordinary skill in the art would have found it obvious to employ ureidopropyltrimethoxysilane as taught by Crompton OSi Specialties into the film-forming composition as taught by Nogami et al. and would have been motivated to do so since Crompton OSi Specialties teaches that ureidopropyltrimethoxysilane offers a number of important benefits including longer pot life than aminosilanes in reactive polymer systems (page 1). This would lead one having ordinary skill in the art to replace the aminopropyltrimethoxysilane as taught in Example 3 of Nogami et al. with ureidopropyltrimethoxysilane.

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nogami et al. (US Pat. 5,800,926), in view of Crompton OSi Specialties (Silquest A-1524 Silane product description found at [http://www.biryong.co.kr/datacenter/chemistry/Silquest\(R\)A1524Silane.pdf](http://www.biryong.co.kr/datacenter/chemistry/Silquest(R)A1524Silane.pdf), published 2002).

Nogami et al. teaches a process for forming a coating film which comprises forming a reaction mixture comprising a tetraalkoxysilane (2:40), a perfluorinated alkoxy silane (2:44), a solvent (2:49), oxalic acid (2:51), and one or more trialkoxy silane modifiers (4:52-5:7), which serve to promote adhesion and reduce the curing temperature of the composition. As a specific

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example, Nogami et al. teaches a film-forming composition comprising (1) tetraethoxysilane [formula (1) of instant claim 10], (2) tridecafluorooctyltrimethoxysilane [formula (2) of instant claim 10], (3) aminopropyltrimethoxysilane, (4) glycidoxypropyltrimethoxysilane (instant claim 11), oxalic acid and ethanol (example 3; 7:22-36). Nogami et al. further teaches the addition of a sol of the types found in instant claim 12. Nogami et al. further explicitly teaches all of the process limitation steps and physical property limitations of instant claim 10 (2:35-3:4).

Nogami et al. does not explicitly teach the addition of an ureidoalkyltrialkoxysilane [formula (3) of instant claim 10]. However, Crompton OSi Specialties teaches ureidopropyltrimethoxysilane. Nogami et al. and Crompton OSi Specialties are combinable because they are from the same field of endeavor, namely, alkoxysilane adhesion promoters. At the time of the invention, a person having ordinary skill in the art would have found it obvious to employ ureidopropyltrimethoxysilane as taught by Crompton OSi Specialties into the film-forming composition as taught by Nogami et al. and would have been motivated to do so since Crompton OSi Specialties teaches that ureidopropyltrimethoxysilane offers a number of important benefits including longer pot life than aminosilanes in reactive polymer systems (page 1). This would lead one having ordinary skill in the art to replace the aminopropyltrimethoxysilane as taught in Example 3 of Nogami et al. with ureidopropyltrimethoxysilane.

Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nogami et al. (US Pat. 5,800,926), in view of Crompton OSi Specialties (Silquest A-1524 Silane product

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Nogami et al. teaches a coating film having the physical properties of instant claim 13 which is formed from a reaction mixture comprising a tetraalkoxysilane (2:40), a perfluorinated alkoxy silane (2:44), a solvent (2:49), oxalic acid (2:51), and one or more trialkoxysilane modifiers (4:52-5:7), which serve to promote adhesion and reduce the curing temperature of the composition. As a specific example, Nogami et al. teaches a film-forming composition comprising (1) tetraethoxysilane [formula (1) of instant claim 13], (2) tridecafluorooctyltrimethyloxysilane [formula (2) of instant claim 13], (3) aminopropyltrimethoxysilane, (4) glycidoxypolypropyltrimethoxysilane (instant claim 14), oxalic acid and ethanol (example 3; 7:22-36). Nogami et al. further teaches the addition of a sol of the types found in instant claim 15. Nogami et al. further explicitly teaches all of the process limitation steps and physical property limitations of instant claim 13 (2:35-3:4).

Nogami et al. does not explicitly teach the addition of an ureidoalkyltrialkoxysilane [formula (3) of instant claim 13]. However, Crompton OSi Specialties teaches ureidopropyltrimethoxysilane. Nogami et al. and Crompton OSi Specialties are combinable because they are from the same field of endeavor, namely, alkoxy silane adhesion promoters. At the time of the invention, a person having ordinary skill in the art would have found it obvious to employ ureidopropyltrimethoxysilane as taught by Crompton OSi Specialties into the film-forming composition as taught by Nogami et al. and would have been motivated to do so since Crompton OSi Specialties teaches that ureidopropyltrimethoxysilane offers a number of important benefits including longer pot life than aminosilanes in reactive polymer systems (page

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Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nogami et al. (US Pat. 5,800,926), in view of Hayashi et al. (US Pat. 6,800,330)

Nogami et al. teaches a coating film having the physical properties of instant claim 1 which is formed from a reaction mixture comprising a tetraalkoxysilane (2:40), a perfluorinated alkoxy silane (2:44), a solvent (2:49), oxalic acid (2:51), and one or more trialkoxysilane modifiers (4:52-5:7), which serve to promote adhesion and reduce the curing temperature of the composition. As a specific example, Nogami et al. teaches a film-forming composition comprising (1) tetraethoxysilane [formula (1) of instant claim 1], (2) tridecafluorooctyltrimethyloxysilane [formula (2) of instant claim 1], (3) aminopropyltrimethoxysilane, (4) glycidoxypentyltrimethoxysilane (instant claim 2), oxalic acid and ethanol (example 3; 7:22-36). Nogami et al. further teaches the addition of a sol of the types found in instant claim 3. Nogami et al. further explicitly teaches all of the process limitation steps and physical property limitations of instant claim 1 (2:35-3:4).

Nogami et al. does not explicitly teach the addition of an ureidoalkyltrialkoxysilane [formula (3) of instant claim 1]. However, Hayashi et al. teaches that aminopropyltrimethoxysilane and ureidopropyltrimethoxysilane are functional equivalents as silane coupling agents/adhesion promoters (14:66-15-25). It is *prima facie* obvious to substitute

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equivalents, motivated by the reasonable expectation that the respective species will behave in a comparable manner or give comparable results in comparable circumstances. *In re Ruff*, 118 USPQ 340. See MPEP 2144.06. The express suggestion to substitute one equivalent for another need not be present to render the substitution obvious. *In re Font*, 213 USPQ 532.

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Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nogami et al. (US Pat. 5,800,926), in view of Hayashi et al. (US Pat. 6,800,330)

Nogami et al. teaches a coating film having the physical properties of instant claim 13 which is formed from a reaction mixture comprising a tetraalkoxysilane (2:40), a perfluorinated alkoxysilane (2:44), a solvent (2:49), oxalic acid (2:51), and one or more trialkoxysilane modifiers (4:52-5:7), which serve to promote adhesion and reduce the curing temperature of the composition. As a specific example, Nogami et al. teaches a film-forming composition comprising (1) tetraethoxysilane [formula (1) of instant claim 13], (2) tridecafluorooctyltrimethyloxysilane [formula (2) of instant claim 13], (3) aminopropyltrimethoxysilane, (4) glycidoxypolypropyltrimethoxysilane (instant claim 14), oxalic acid and ethanol (example 3; 7:22-36). Nogami et al. further teaches the addition of a sol of the types found in instant claim 15. Nogami et al. further explicitly teaches all of the process limitation steps and physical property limitations of instant claim 13 (2:35-3:4).

Nogami et al. does not explicitly teach the addition of an ureidoalkyltrialkoxysilane [formula (3) of instant claim 13]. However, Hayashi et al. teaches that

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aminopropyltrimethoxysilane and ureidopropyltrimethoxysilane are functional equivalents as silane coupling agents/adhesion promoters (14:66-15-25). It is *prima facie* obvious to substitute equivalents, motivated by the reasonable expectation that the respective species will behave in a comparable manner or give comparable results in comparable circumstances. *In re Ruff* 118 USPQ 340. See MPEP 2144.06. The express suggestion to substitute one equivalent for another need not be present to render the substitution obvious. *In re Font*, 213 USPQ 532.

Response to Arguments

Applicant's arguments filed 6/30/08 have been fully considered but they are not persuasive.

For the prior art rejection of Nogami et al. in view of Crompton OSi, Applicants argue there is nothing disclosed in the references which would lead a person of ordinary skill in the art to add the ureido compound to the combined reactants of Nogami et al. in order to achieve the advantages of a coated film having a low refractive index and having a satisfactory hardness. However, the motivation to add the ureido compound as taught by Crompton OSi, cited in the rejection above, does not have to be the same as the Applicant's. The fact that the Applicant's have recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Further, there is nothing in the instant claims requiring satisfactory hardness. Moreover, the Comparative Example 1 of the instant specification employs aminopropyltrimethoxysilane. The refractive index and contact angle values for the composition of Comparative Example 1 falls within that

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which is required by the instant claims. As such, in view of the Applicant's arguments, the prior art rejection of Nogami et al. in view of Crompton OSi is wholly maintained.

For the prior art rejection of Nogami et al. in view of Hayashi et al., Applicant's argue that Hayashi et al. discloses a number of trialkoxysilanes which are used as coupling agents. Applicants further argue that the function of the ureidosilyl group containing compound of the instant application has to do with providing a good hardness, low refractive index coated film. However, the fact that these features are not disclosed or suggested in the relied upon prior art references is not sufficient grounds for removal of these references. Stated differently, Nogami et al. in view of Hayashi et al. collectively teach the claimed compositions and as such would inherently display the good hardness and low refractive index values in the coated films prepared therefrom. The fact that the Applicant's have recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT LOEWE whose telephone number is (571)270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-13021302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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7-Jul-08

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